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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,309	02/21/2002	Gary John Corey		9106

7590 07/30/2004

Mr. Gary John Corey  
21445 Bundy Canyon Road  
Wildomar, CA 92595

EXAMINER

PALADINI, ALBERT WILLIAM

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/079,309

Applicant(s)

COREY, GARY JOHN

Examiner

Albert W Paladini

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing

subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In the amended section entitled "DETAILED DESCRIPTION OF THE INVENTION" on pages 20-28, there is no actual description of the inventions elements or operation. The description provides an operating manual for a tool that is already in existence. It specifies how an operator may enter inputs for control of a machine, but it does not describe the technical components of the tool and how they interrelate functionally as an invention. The specification provides no description of the components constituting the claimed "technology element" recited in the claims. There is no description or drawing (such as a block diagram) of the internal components and their functional interactions to perform the function recited in the preamble to the claims. In order to demonstrate that the invention can perform the function or functions recited, the specification must provide a technical description of the internal components or elements of the "technology element and a clear explanation of how these elements function in concert to achieve the desired objective or objectives.

For example, it states on page 20 "On FIG. 1, the box labeled 'Hoirz' is used by the machine operator to enter the horizontal offset value that will be used to compensate for the tool location horizontally." There is no description of elements of the tool, which are alleged to perform any of the functions suggested.

Another example on page 20 of the DETAILED DESCRIPTION is "On FIG 1, the box labeled 'Corner radius' is used to enter a value by the machine operator that would be used by the internal algorithm to compensate or adjust for the radius on the end of the tool." This is an instruction that might be utilized in an operator's manual, but there is no technical description of the internal elements of the tool and how it is capable of performing the function suggested.

On page 23, another example is "The offset values entered for each axis will be added to the current position of the tool together with all other invoked offsets." This is a description of data that might be entered by an operator, but no tool system and components have been described.

On page 24, it states "The TOOLCOMP command enables 3D and 5-axis tool compensation and has eight possible parameters." This contains more user input descriptions, but no description and explanation of the actual engineering components and systems needed to support the purported functions.

The entire DETAILED DESCRIPTION OF THE INVENTION provides user input instructions, and associate formats for the inputs. It suggests functions that might be performed by the machine. However, there is no technical or engineering description of an actual machine or system, which has interactive elements to support the functions

suggested in the description. The specification consists of menus to input data, and does not describe the components and functionality of an invention.

The specification must enumerate the elements of the invention, and explain how these elements work in concert to perform the desired function. It may also be useful to provide drawings of the invention to clearly explain the verbal description. This specification makes assertions about the possible capabilities of the invention, but does not provide a description of how to make or use the invention.

The Manual of Patent Examining Procedure states:

"608.01 Specification [R - 3]

35 U.S.C. 22. Printing of papers filed.

The Commissioner may require papers filed in the Patent and Trademark Office to be printed or typewritten.

37 CFR 1.71. Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(o). The content of the notice must be limited to only those elements required by law. For example, "E1983 John Doe" (17 U.S.C. 401) and "M John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or

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mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to {copyright or mask work} protection. The {copyright or mask work} owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all {copyright or mask work} rights whatsoever.

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be cancelled. See 37 CFR 1.78 and MPEP § 202.01.

608.01(p) Completeness [R - 2]

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in MPEP § 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date, *In re Glass*, 492 F.2d 1228; 181 USPQ 31 (CCPA 1974).

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques, where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. Markush claims must be provided with support in the disclosure for each member of the Markush group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications.

For "Guidelines for Examination of Applications for Compliance with the Utility Requirement of 35 U.S.C. 101", see MPEP § 706.03(a)(1).

For "Overview of Legal Precedent Governing Utility Requirement", see MPEP § 2107.

For a discussion of the utility requirement under 35 U.S.C. 112, first paragraph, in drug cases, see MPEP § 2164.07(a)(4).

For "Procedural Considerations Related to Utility Rejections", see MPEP § 2107.01.

For "Special Considerations for Asserted Therapeutic or Pharmacological Utilities", see MPEP § 2107.02."

Appropriate correction and clarification is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting elements and essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary elements and structural connections. See MPEP § 2172.01.

### **Claim 1**

The preamble recites "a technology element that calculates Multi-Axes Tool compensation." The body of the claim beginning on line 6 and including a through f is a menu for settings to be inputted by a user to achieve the goal recited in the preamble. There is no recitation of the components which constitute the "technology element" and the structural and functional relationships between the components which enable the "technology element" to perform the recited objective of "Multi-Axes Tool compensation." A single element "technology element" is recited, and this is followed by a user input menu. The claim must recite all of the elements, which constitute the "technology element" in addition to the structural and functional relationship between the elements, so that the actual functioning of the invention is understood. Providing only a user data input menu is not proof that the "technology element" consists of elements, which work cooperatively to perform the desired objective.



### **Claim 2**

The claim recites an objective to "calculate tool gauge avoidance protection" without reciting the components or elements and their relationship with the components or elements of the base claim 1 which perform this objective. To further limit claim 1, the dependent claims must recite additional components to that recited in the base claim.

### **Claim 3**

The claim is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. This claim is a method claim and does not further limit apparatus claim 1. To further limit claim 1, the dependent claims must recite additional components to that recited in the base claim. In addition it only recites a desired objective. If it were a method claim it would need to state the steps required to achieve the final desired objective. It is not sufficient to recite an objective without reciting the components and or methodology of performing the invention.

### **Claim 4**

The claim is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. This claim is a method claim and does not further limit apparatus claim 1. In addition it only recites a desired objective. To further limit claim 1, the dependent claims must recite additional

components to that recited in the base claim. If it were a method claim it would need to state the steps required to achieve the final desired objective. It is not sufficient to recite an objective without reciting the components and or methodology of performing the invention. If it were a method claim, the recitation on line 2, which states, "which does not depend on the CNC programmer" is not a step, but a negative limitation. A step claim limitation must be a positive assertion and not a recitation of what is not done or "does not depend on." Nevertheless, the base claim is an apparatus claim, so that this limitation is not a valid limitation.

#### **Claim 5**

The claim recites an objective "which allows the machine operator to override the pre-defined tool characteristics by entering the setting defined values as described by and shown in FIG 1 on the operator screen." without reciting the components or elements and their relationship with the components or elements of the base claim 1 which perform this objective. To further limit claim 1, the dependent claims must recite additional components to that recited in the base claim.

#### **Claim 7**

Claim 7 recites, "I, Gary John Corey, solely invented Multi-Axes Tool compensation technology based on research I conducted as a CNC machinist." This also is not valid as a claim, since it does not describe an invention or inventive step. Any statement of ownership is contained in the Declaration.

### **Claim 9**

The preamble recites, "I claim an algorithm element according to Claim 1." However, claim 1 recites a "technology element." It is not understood if this algorithm element is meant to be the same "technology element" recited in claim 1.

Then, the body of the claim recites in a general narrative form objectives such as "ever changing database," "memory that remembers by learning from what the machine can and cannot do," "The database is a storage of events," etc. These are objectives of the invention and not elements or components added which further limit the base claim 1.

Statements of what the element, component, or machine are intended to accomplish are not limitations which recite how components or elements connected together operate cooperatively to achieve the objectives recited in the preamble. The base claim is incomplete in that it does not recite a complete operating collection of elements or components. The dependent claims either list a menu for entering data or state more objectives of the invention without providing descriptive support of elements, which can accomplish the desired objectives. The base claim is incomplete in that it does not recite a complete operating collection of elements or components. The dependent claims either recite menus for entering data, or state further objectives without providing the supporting technological components and structure necessary to achieve the objectives. Merely reciting that you have a machine that can perform a function is not sufficient to support an invention.

Appropriate correction and clarification is required.

Section 2106 (i) from the Manual of Patent Examination Procedure is reproduced below. This explains that a recitation of the intended use of the invention is not sufficient to describe the invention.

**2106 (i) Intended Use or Field of Use Statements**

Claim language that simply specifies an intended use or field of use for the invention generally will not limit the scope of a claim, particularly when only presented in the claim preamble. Thus, Office personnel should be careful to properly interpret such language. *Walter*, 618 F.2d at 769, 205 USPQ at 409 (Because none of the claimed steps were explicitly or implicitly limited to their application in seismic prospecting activities, the court held that "[a]lthough the claim preambles relate the claimed invention to the art of seismic prospecting, the claims themselves are not drawn to methods of or apparatus for seismic prospecting; they are drawn to improved mathematical methods for interpreting the results of seismic prospecting."). Cf. *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1558. When such language is treated as nonlimiting, Office personnel should expressly identify in the Office action the claim language that constitutes the intended use or field of use statements and provide the basis for their findings.

**This will shift the burden to applicant to demonstrate why the language is to be treated as a claim limitation.**

The portion of the Manual of Patent Examining Procedure which describes the required content of the claims is reproduced below.

"608.01(i) Claims [R - 3]

37 CFR 1.75. Claims

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim" ) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under §

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1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (See § 1.58(a).)

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and

(3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

\*\*>(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation."

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

In Claim 8, the Applicant states "Multi-Axes Tool Compensation has been in development and field use since 1991 by my customers." Since the Application was filed on February 21, 2002; the invention has been in public use for more than one year prior to the date of application for patent in the United States.

7. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: A detailed description of how, when, and to whom this invention was made available.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

#### ***Relevant Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Link (4608747) discloses a controller for a multi-axes lathe using a CNC controller which has a safety partition to protect the operators when the work spindle is in the working position.

Schulz (6022132) discloses a method and apparatus for programming a multi-axes tool using encoders on each axis. A probe, with outputs to transducers, mounted in the spindle defines the desired cutting path.



Kamiguchi (6167325) discloses a multi-axes tool controller with a data correction method which compensates for the difference between an actual machining position, and the command position.

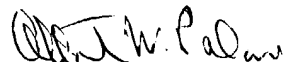
Hammerle (6225771) discloses a probe chord error compensation tool for use with a CNC processor and a multi-axes tool.

8. Any inquiry concerning this communication or earlier communication from the examiner should be direct to Albert W. Paladini whose telephone number is (703) 308-2005. The examiner can normally be reached from 7:30 to 3:30 PM on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Leo P. Picard, can be reached on (703) 308-0538. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

July 26, 2004

  
Albert W. Paladini  
Primary Examiner  
Art Unit 2125